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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,529	11/16/2001	Shelton Louie	1205-009/JRD	4344

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IPSOLON, LLP (JRD)  
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PORTLAND, OR 97201

EXAMINER
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GORT, ELAINE L

ART UNIT	PAPER NUMBER
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3627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/991,529	LOUIE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Elaine Gort	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 7/12/06.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (200410036623) in view of Erickson et al (2002/0180588).

Chung shows receiving a prescription order (for example prescription order discloses as having check smart tag 200-Rx therewith, see paragraph [0135];

tagging the order with an RFID tag (such as the check smart tag 200-Rx attached to the order, paragraph [0135] that travels with the order, the tag is in communication with a computer system (this is done via reader 42 disclosed in paragraph [0136] that correlates the order with the tag (the order is identified via the tag, therefore the computer correlates the tag with the prescription order, paragraph [0136] discusses how

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the order with the tag is scanned to identify the particular prescription or order with the tag); and

activating an alert to a pharmacy worker in response to a predetermined criteria detected by the computer system (such as a confirmation that the order is proper or that there are problems, see paragraphs [0136] and [0138].

Chung is silent regarding the RFID tag having a worker signaling device. Erickson et al. teaches that it is old and well known in the art of RFID tags to use worker signaling devices on the tags in order to allow the tagged items themselves to provide information to workers (for example see paragraphs [0002], [0003] and [0041 which discuss audio and lights for signaling status information to workers]. It would have been obvious to one of ordinary skill in the art to modify the method of Chung by using the worker signaling device as taught by Erickson et al. in order to allow the tagged items themselves to provide information to workers and to locate these tagged items. For example in this scenario the tagged order could indicate to the worker that the order is confirmed or if there are problems by emitting a sound or having lights which previously had to be shown on the computer screen to the worker. The worker signaling device could also be used to locate the order if it becomes lost or if it has been out too long (based on a timer, see Erickson [0018].

(Regarding multiple lights, audio speakers and transducers) Examiner takes Official Notice that it is notoriously old and well known in the art of signaling to provide multiple types of alert devices in order to communicate different things and in different ways. It would have been obvious to one of ordinary skill in the art to further modify the

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method, as modified above, with a plurality of alert devices, such as different colored LEDs and speakers to communicate different things in different ways. For example a red or yellow light, typically indicating a problem, could be used to indicate a problem exists, while a green light could be used to indicate everything is good. Another example is that the device could audibly state that the order is confirmed or that a problem exists and an audible sound could be used for locating a misplaced or filed order.

(Regarding displaying the order's location on a computer) Chung in view of Erickson et al show all elements of the claim but is silent regarding displaying the location of the tag on a computer monitor. However, to do so is notoriously old and well known in the art in order to track items. It would have been obvious to one of ordinary skill in the art to further modify the method as modified above by stating or showing the tag's location on a monitor in order to show the user the general location where the order is.

(Regarding a timer on the tag) Examiner takes Official Notice that it is notoriously old and well known in the art of computer systems to relocate features within the system to remove loads from busier parts of the system and/or to allow features to operate if other parts of the system are down. It would have been obvious to one of ordinary skill in the art to further modify the method, as modified above, by putting the timer on the tag in order to remove load from the central system and transmitter and to ensure the timer feature works if the computer system fails.

Alternatively, Chung in view of Erickson et al., as modified above, show all elements of the claim except that the timer is on the tag. However, it would have been an obvious matter of design choice to place the timer on the tag since the placement of the timer solves no particular problem or is for no specific purpose and it appear that the system would function equally well in either configuration.

(Regarding workers initiating alerts via the computer) Erickson et al. teaches (e.g. paragraph 41) that it is old and well known in the art of computer alert system to initiate alerts from a computer by a worker to allow the item to be located or to sent information to the device. It would have been obvious to one of ordinary skill in the art to further modify the method, as modified above, by allowing workers to initiate alerts from the computer system to allow the item to be located or to send information to the device.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive.

The Applicant has argued that neither reference teach or suggest activating a warning device on the tag itself in response to predetermined criteria detected by a computer system that is in communication with that warning device. Examiner contends that Chung discloses activating an alert to a pharmacy worker over the computer system in response to a predetermined criteria detected by the computer system (such as a confirmation that the order is proper or that there are problems, see paragraphs

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[0136] and [0138]). Examiner also contends that Erickson et al. teaches that it is old and well known in the art of RFID tags to use worker signaling devices on the tags in order to allow the tagged items themselves to provide information to workers (for example see paragraphs [0002], [0003] and [0041 which discuss audio and lights for signaling status information to workers]. Examiner therefore contends that it would have been obvious to one of ordinary skill in the art to modify the method of Chung by using the worker signaling device as taught by Erickson et al. in order to allow the tagged items themselves to provide information to workers and to help locate these tagged items. Instead of the worker having to look at the computer screen, the item itself would provide the information that used to be provided on the screen. Therefore the Examiner contends that the modified system would use the predetermined criteria of Chung and activate a warning device on the tag to communicate this information to allow the item itself to communicate the status. This is more convenient for the worker.

The Applicant has argued there is no teaching to provide a timing element with the Chung Reference. Examiner agrees as the Examiner has used the timer in Erickson, paragraph [0018], for tracking the time.

The Applicant has traversed the examiner's reliance on "common knowledge". To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art MPEP Sec. 2144.03(C). See 37 CFR1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ. The Applicant has merely made a blanket statement contesting the official notice taken

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without pointing out how the specific official notice is erroneous. For example how it is not old and well known in the art of signaling to provide multiple types of alert devices in order to communicate different things and in different ways.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571/272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elaine Gort  
Primary Examiner  
Art Unit 3627

February 17, 2007